

REMARKS

Claims 1 - 40 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC 103(a) Over Lee at al. 5,792,412 in view of Shaw et al. 6,420,003

Claims 1 - 40 have been rejected under 35 USC 103(a) as being unpatentable over Lee et al. 5,792,412 in view of Tanaka et al. 5,801,238. The Examiner concluded that, "It would be obvious to one of ordinary skill in the art to use a coating of the water absorbents taught by Tanaka in the invention of Lee because of their high absorbency properties, which are known as valuable in the art." (Emphasis added)

Section 706.02(j) of the MPEP lists three requirements for establishing a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. Applicants respectfully submit that the Examiner has failed to meet --at least one, etc.-- of the above requirements, therefore, has not established a *prima facie* case of obviousness based on the cited references.

Applicants respectfully traverse the rejection on the ground that the Office Action has not met the requirements of MPEP § 2143 for establishing of a *prima facie* case of obviousness with regard to the rejected claims. As shown below, the Applicants respectfully submit that the Examiner has failed to show at least one of the three requirements of a *prima facie* case of obviousness, for example, the references provide no motivation to combine.

Tanaka teaches a water absorbent resin made by radiation curing. Tanaka also teaches that such absorbent resin can be used inside an absorbent article, specifically, in the absorbent core, to take advantage of its water absorbency, i.e., water holding capability.

In contrast, the present invention relates to the modification of the topsheet of an absorbent article such that the topsheet may facilitate the transmission of water through the topsheet into the absorbent article.

First, Tanaka is silent regarding any treatment of the topsheet. There is no teaching or suggestion in Tanaka to use the absorbent resin anywhere but in the absorbent core, inside the absorbent article. The Court has held that combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *See e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). Applicants respectfully submit that since there is no teaching or suggestion in the references the present rejection is based on such hindsight reconstruction of the present invention.

Further, water holding capability as taught by Tanaka would lead one skilled in the art to conclude that a wet topsheet surface may result, if Tanaka's water absorbent resin were placed on the topsheet. Such topsheet treatment to hold water on the topsheet would deliver a wet feel to the wearer's skin, which is clearly an undersirable result and contrary to the present invention. Thus, Tanaka **teaches away** from the presently claimed invention.

Conclusion

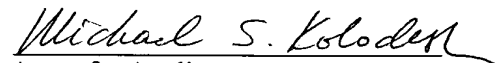
In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application and allowance of the pending Claims 1-40.

Respectfully submitted,

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